

00



UNITED STATES PATENT AND TRADEMARK OFFICE

3

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,677	12/19/2000	Robert Eustace Novak	005217.P017	9916

33318 7590 12/01/2004

DIGEO, INC.
 8815 122ND NE
 KIRKLAND, WA 98033

EXAMINER

SRIVASTAVA, VIVEK

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

00

9/4

Office Action Summary	Application No. 09/742,677	Applicant(s) NOVAK, ROBERT EUSTACE	
	Examiner Vivek Srivastava	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 9 – 11, 13 – 17, 19, 21, 22 and 24 – 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al (6,774,926).

Regarding claims 1 and 13, Ellis discloses a method, system and article of manufacture for providing a user with EPG data comprising both traditional television and personal television channels (see col 9 lines 15-25 and fig. 9). It is noted that the personal channels meet the claimed “synthetic channel” and thus Ellis discloses “establishing a synthetic channel as a channel among a plurality of broadcast channels of an interactive video casting system” also noting that the EPG is interactive (see col 8 lines 50 – 55). Ellis further discloses that a user can select a video for viewing on a personal channel and also discloses selecting website links associated with the personal television channels and displaying the corresponding webpage (see col 15

Art Unit: 2611

lines 40 – 52). It is noted that the webpage with associated web link meets the claimed “media object” limitation, the web link and associated web page is part of a media program, and that web link is stored at the cable system headend. Ellis further discloses providing the media program and the web link and webpage via the synthetic channel (see col 15 lines 40 – 52).

Regarding claim 2, Ellis discloses the claimed interactive television system (see col 8 lines 50 – 55).

Regarding claims 4 and 14, Ellis discloses a headend and ISP comprising a servers 116 (see fig. 7) for providing a digital stream (see col 4 lines 48 – 54) i.e. and MPEG data stream (see col 3 lines 44 – 50).

Regarding claims 5 and 15, Ellis discloses users desiring to view the personal program must enter a password or “subscribe” the client terminal to receive the media program via the synthetic channel (see col 11 line 52 – col 12 line 16).

Regarding claims 9 and 16, Ellis discloses a contributor, or a viewer, can upload a video i.e. media program to the server and have that media program incorporated into an EPG according the contributors schedule (see col 7 lines 29 – 48, col 8 lines 18 – 27, col 11 lines 45 – 52 and col 12 lines 47 – 57). It is noted that the server obtains the uploaded or stored program schedule information associated with uploaded or stored video and that the video program and schedule is added to the EPG to indicated availability.

Regarding claim 10, Ellis discloses monitoring viewer requests for programs stored at the servers (see col 10 lines 55 – 60) and thus discloses the claimed “media

program can be provided to the client terminal in response to a command sent from the client terminal that requests the media program”.

Regarding claim 11, Ellis discloses distributing personal television programs via the Internet (see Abstract) and thus discloses the synthetic channel comprises part of the TCP/IP channel.

Regarding claim 17, Ellis discloses an EPG (see fig 9) comprising a first set of traditional television channels 134 (see col 9 lines 15 – 25) and thus discloses the claimed “a first set of displayable programming information” and discloses an a second set of personal channels 136 and thus discloses the claimed “second set of displayable programming information related to a media program available via a synthetic channel different from broadcast channels among the group of broadcast channels (see col 9 lines 15 – 25). Ellis further discloses a video can be uploaded to a server and incorporated within the EPG (see col 7 lines 30 – 57 and col 8 lines 18 – 26) and also discloses the uploaded video can be scheduled to be displayed according to a contributors or users instructions thus permitting access and display of the media object if the synthetic channel is selected (see col 11 line 11 to col 12 line 1 and col 12 lines 47 – 57). It is noted that the component of the EPG is inherently included since the EPG can be edited to include the uploaded video and schedule provided by the contributor or user.

Regarding claim 19, Ellis discloses a uploading i.e. transferring and storing a video or media object and also discloses incorporating the video into an EPG (col 7 lines 30 – 48, col 8 lines 18 – 49) which stored in program schedule database 54 (see

Art Unit: 2611

fig 2) and thus discloses the claimed "wherein the second set of displayable programming information is obtainable from a storage location associated with the uploaded media object".

Regarding claim 21, Ellis discloses the personal channels or second set of displayable programming information is capable of being updated by a contributor or user who desires to incorporate a uploaded video and a schedule for the video in the EPG (see col 7 lines 10. 57 and col 8 lines 18 – 49).

Regarding claim 22, Ellis discloses the client terminal can be a computer (see col 3 lines 1 – 5) and that the communication network can be the internet (see fig 7) and further disclose uploading an video the ISP server. It is noted that a client computer coupled to the internet inherently comprises an address indicative of the source of the address identifying which computer the uploaded video was sent from.

Claim 24, 25, 29 and 30 are met by the above discussions above.

Regarding claim 26, Ellis discloses the client terminal is a television which inherently comprises an audio device (see col 3 lines 1-5).

Regarding claim 27, Ellis discloses a user can upload a video to a server in the interactive television network (see col 7 lines 30 – 50 and col 8 lines 18 – 25).

Regarding claim 28, Ellis discloses a contributor or user can enter schedule information via an interface (see col 11 line 45 – col 12 line 1).

Claim Rejections - 35 USC § 103

Art Unit: 2611

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al (6,774,926) in view of Crowther et al (4,937,866).

Regarding claim 6, although Ellis discloses subscriber terminal by user entering a password, Ellis fails to disclose using a subscription token to add the synthetic channel as a channel recognizable by the client terminal.

In analogous art, Crowther teaches a television system which loads tokens into the subscriber's controlled sub-system to control access to a pay-per-view channel. It would have been obvious modifying Ellis based on the teaching of Crowther to use subscription tokens to add the personal channel to ensure only authorized clients are able to view the personal channel. Therefore, it would have been obvious to one having ordinary skill in the art to modify Ellis to include the claimed limitation to ensure only authorized clients are able to access the personal channel thus providing a more secure system.

Regarding claim 7, the combination of Ellis and Crowther discloses the claimed limitation, wherein Ellis discloses providing the media program to a client via the Internet (TCP/IP) and thus inherently discloses the claimed "obtaining address information of the client terminal" since the media program is sent to requesting client.

Regarding claim 8, the combination of Ellis and Crowther discloses the claimed limitation, wherein Ellis discloses linking the client address information (as discussed in claim 7 above) with identifying information associated with the media program stored in the headend as discussed in claim 1.

Claims 3, 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al (6,774,926).

Regarding claim 3, Ellis discloses a web link /website as the media object but fails to disclose wherein the media object comprises an audio file. The Examiner takes Official Notice it would have been well known to transmit an audio file to provide a user with audio information for which a user might to hear. For example, in the interactive video distribution art, it is well known to provide a viewer with an audio/video file or audio/video file link to provide a user with a more complete interactive multimedia experience by providing both audio and video. Therefore, it would have been obvious to one having ordinary skill in the art to modify Ellis to include the claimed limitation to provide a user with audio information to provide a more complete multimedia experience comprising both audio and video.

Regarding claim 18, Ellis discloses storing the EPG remotely and delivery the EPG to a client television, settop box or computer but fails to disclose wherein the first and second sets of displayable programming information are storable at a client-side storage location coupled to a client terminal.

The Examiner takes Official Notice that local storage of an EPG is notoriously well known to provide a readily available EPG to the user when needed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ellis to include the claimed client-side storage of the EPG to provide an readily available and quickly retrievable EPG.

Regarding claim 23, Ellis fails to disclose the claimed wherein the address comprises a URL. The Examiner takes Official Notice that use of URL is notoriously well known to provide address information. For example, in the interactive video distribution art, URL's are a well known to provide quick linkage and address information. Therefore, it would have been obvious to one having ordinary skill in the art to modify Ellis to include the claimed URL to provide a well known means for providing quick linkage and address information.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al (6,774,926) in view of Musgrave (6,208,746).

Regarding claim 12, Ellis fails to disclose the claimed providing piracy-discouragement feature to track a source and destination of the at least one media object.

In analogous art, Musgrave teaches a piracy detection system using a biometric watermark, wherein a receiver decoding the watermark without removing the watermark can monitor piracy of the bitstream. Musgrave further teaches "Any subsequent piracy of the bitstream may be traced to any person involved in subsequent transfers and/or

copying of the bitstream..." (see col 43 lines 15 – 25). Tracing the bitstream from subsequent transfers and copying would track a source and destination. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ellis to include the claimed feature to discourage piracy by tracing subsequent transfers and copying of data.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al (6,774,926) in view of Eyer (US 2001/0049720).

Regarding claim 20, Ellis discloses after a contributor provides information to edit the EPG the EPG is transmitted to viewers and can be accessed by viewers only if the viewers enter a correct password, thus Ellis discloses displaying programming information subsequent to the use of the component (discussed in claim 17). Ellis fails to disclose wherein the second set of displayable programming information is displayable subsequent to the use of the component to perform a subscription of a client terminal that is capable to trigger display of the first set of displayable programming information.

Eyer teaches and EPG webpage which lists only the authorized channels for the requesting STB, i.e., the STB user's subscribed channels. It would have been obvious to modify Ellis to include displaying the personal channels only if the user is authorized or is subscribed to receive the personal channels to reduce the size and quantity of information in the EPG. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ellis to include the claimed

Art Unit: 2611

limitation to reduce the size and amount of information in the EPG and to provide only the information which is relevant to a user.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Oral (6,670,971) – creating a user selectable channel

Arai et al (6,486,920) – EPG including a personal channel

Levitan (5,534,911) – Virtual personal channel in a television system


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (703) 305-4038. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs
10/28/04



VIVEK SRIVASTAVA
PRIMARY EXAMINER